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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,935	07/11/2003	Catherine Drogin	465/2	3966

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EXAMINER

COMSTOCK, DAVID C

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/617,935	Applicant(s) DROGIN ET AL.	
	Examiner David Comstock	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The amendment filed 15 November 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "*wherein said tongue depressor does not have a protective layer*" (see amended claim 1 and new claims 17 and 18). This amendment was made in an apparent attempt to overcome the Esker et al. reference by using the same terminology used in that reference. However, there is not support for that language. Rather, Applicant's original disclosure at most implicitly supports a negative limitation pertaining to a separate "cover strip" similar to that found in U.S. Pat. No. 3,867,927, as referred to by Applicant in the original disclosure (see Specification, page 4). It is noted that while Esker et al. may comprise an integral protective layer forming the blade or body of that device, it does not utilize a separate covering strip to be placed on the device, as set forth in Applicant's disclosure and the '927 reference referred to by the same.

Furthermore, additional new matter not supported by the original disclosure is as follows: "*wherein both ends of said tongue depressor may be safely received within said mouth of said patient during said examination without causing any discomfort or physical harm*" (see amended claim 1 and new claim 17). This language has been added in an apparent attempt to overcome Esker et al. and Daly et al. However, this

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language is not found in the original disclosure. At most the original disclosure supports a limitation that any part of the device may be received within the mouth of a patient, a limitation which the devices of Esker et al. and Daly et al. both satisfy.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Objections

Claims 1-11 and 13-18 are objected to because of the following informalities: In claims 1, 17 and 18, the word(s) "Wherein" should be changed to --wherein-- (remove capitalization). Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6, 8-11 and 13-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 8, "the standard size used with youthful patients" lacks antecedent basis. Furthermore, it is unclear exactly what this size should be since it was not defined or quantified in the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Esker et al. (5,946,773).

Esker et al. disclose a device 10 comprising a sterile blade 12 having a first side 16 and a second side 18 (see Figs. 1-6 and col. 1, lines 4-9). Various ornamental images formed of biocompatible inks appear on both sides 16, 18 of the device and may be multi-colored (id. and see col. 2, lines 25-37 and col. 4, lines 1-16 and 60-63). The images cover substantially all of both sides in various patterns and configurations. It is noted that an image on the first side can be the same as an image on the second side, e.g. a bunch of grapes (see Fig. 3). In addition, an image on the first side, e.g. a bunch of grapes, can be different from an image on the second side, e.g. an apple. The sides 16, 18 of the device can be contacted by a user's tongue. Any portion of the device, including a portion with an image, can be received within a user's mouth due to the biocompatibility of the ink forming the images and an additional biocompatible protective layer (see col. 2, lines 28-48). The device is made of plastic, i.e. styrene, and is protected with a layer of plastic (see col. 2, lines 38-51).

Claims 12, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Daly et al. (910,914).

Daly et al. disclose an unflavored disposable utensil 10 comprising a sterile wooden blade having first and second sides (see Fig. 2; col. 1, lines 30-31, 36-37, 47-49). The first and second sides are received within a mouth and can contact a user's tongue. The device includes ornamental advertising images formed of non-poisonous ink that does not interfere with the hygienic qualities of the utensil (see Fig. 2 and col. 1, line 55 - col. 2, line 3). It is noted that letters and words appeal to children.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 9, 11 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Esker et al. (5,946,773).

Esker et al. disclose the claimed invention except for the device having the specific size claimed by Applicant. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Esker et al. in any of numerous size, since a mere change in the size of a component is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Claims 1-6 and 8-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daly et al. (910,914).

Daly et al. disclose the claimed invention except for the device having the specific size claimed by Applicant. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Daly et al. in any of numerous sizes, since a mere change in the size of a component is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Providing multiple colors would have been further obvious since single and multi-color printing are known equivalents in the art at the time of the invention, the difference amounting to nothing more than an obvious choice of design. It also would have been obvious to one having ordinary skill in the art at the time the invention was made to duplicate the images so as to have them on both sides of the device, since it has been held that mere duplication of the essential elements of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Moreover, providing different images on each side is merely one of numerous configurations a person of ordinary skill in the art would find obvious. *In re Dailey and Eilers*, 149 USPQ 47 (1966). With regard to claims 9 and 10, Daly et al. do not disclose forming the device from cardboard or plastic. However, it also would have been obvious to one having ordinary skill in the art at the time the invention was made to form the device from cardboard or plastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claims 1-6 and 8-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (2004/0109932) in view of Esker et al. (5,946,773).

Chen et al. disclose a tongue depressor, which includes two sides and two tongue contact portions (see paragraphs 0002, 0003, 0063 and 0064). Tongue depressors are sterile. Chen does not disclose providing an ornamental image. Esker et al. disclose a similar device having decorative images formed from biocompatible inks on both sides of the device to make the device attractive and entertaining and to make the device more valuable to the user (see Figs. 1-6; col. 2, lines 25-37; and col. 4, lines 1-16 and 60-63). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the tongue depressor of Chen et al. with decorative images formed from biocompatible inks on both sides of the device, in view of Esker et al., in order to make the device attractive and entertaining and to make the device more valuable to the user. It is noted that providing different images on the two sides would have been an obvious matter of design choice, since applicant has not disclosed that providing the images in this way solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well without providing the images in this manner. Moreover, providing different images on each side is merely one of numerous configurations a person of ordinary skill in the art would find obvious. *In re Dailey and Eilers*, 149 USPQ 47 (1966). The sides of the device of the combination of Chen et al. and Esker et al. can be contacted by a user's tongue, and any portion of the device, including a portion with an image, can be received within a user's mouth due to the biocompatibility of the ink forming the images and an additional biocompatible protective layer (see col. 2, lines 38-48). It also would have been obvious to form this device from wood, plastic, cardboard, or any of numerous other known

materials, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Response to Arguments

Applicant's arguments filed 15 November 2004 have been fully considered but they are not persuasive.

In response to Applicant's argument regarding the size of the device, it is noted that a mere change in the size of a component is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). With regard to what is considered to be a decoration on the device, it is noted that letters and words are very appealing to many children. It is further noted that Applicant apparently recognized this obvious point in the specification where it is explained that the ornamental image can be "*any known image or writing, including, but not limited to, patterns, images, cartoon characters, corporate logos, advertising messages [as in Daly et al.], or any other image that is appealing to children.*" (Page 7, lines 27-29, *emphasis added*.)

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Comstock whose telephone number is (703) 308-8514.



D. Comstock
03 February 2005



EDUARDO C. ROBERT
PRIMARY EXAMINER